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10/706,378	11/12/2003	David John Smith	CM-2477M2D	6378
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THE PROCTER & GAMBLE COMPANY			WEBB, GREGORY E	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DAVID JOHN SMITH, SANJEEV SHARMA,  
JAMES IAIN KINLOCH, and SIMON JOHN GREENER

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Appeal 2009-013791  
Application 10/706,378  
Technology Center 1700

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Before EDWARD C. KIMLIN, CHARLES F. WARREN, and  
CATHERINE Q. TIMM, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

I. STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision to reject claims 1-41 under 35 U.S.C. § 102(e) as anticipated by Roberts (US 2002/0077264 A1; published Jun. 20, 2002), Sommerville-

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

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Roberts (US 2005/0049164 A1; published Mar. 3, 2005), or Pfeiffer (US 6,492,312 B1, issued Dec. 10, 2002). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Appellants' invention relates to a unit dose of a dishwashing product in pouch form for use in an automatic dishwashing machine (Spec. 1:20-24).

Claim 1 is illustrative:

1. A water-soluble pouch for use in an automatic dishwashing machine comprising one or more dishwashing compositions in a unit dose form, said water-soluble pouch having a degree of deformability greater than about 5% and a shape and size such that said water-soluble pouch occupies more than about 40% of the volume of an individual compartment of a dispenser compartment of an automatic dishwashing machine that has one or more individual compartments when said dispenser compartment is in a closed state.

## II. DISPOSITIVE ISSUE

Appellants present substantially identical arguments with respect to each of the rejections, namely, that none of the prior art references teaches a pouch having the degree of deformability recited in the claims (Br. 3-8). The dispositive issue arising from the contentions of Appellants and the Examiner is: does the evidence support the Appellants' view that the Examiner erred in finding that the prior art teaches, either expressly or inherently, a pouch having the "degree of deformability" recited in the claims? We answer this question in the negative.

## III. DISCUSSION

The Examiner finds that "the prior art films, method of making the pouch and materials found within the pouch are each identical to the instant

invention” and on this basis concludes that “the properties of the instant pouch are inherently disclosed by the prior art” (Ans. 8).

When a claimed product appears to be substantially identical to a product disclosed by the prior art and when the PTO has no reasonable method of determining whether there is, in fact, a patentable difference between the prior art materials and the claimed material, the burden is on the Appellants to prove that the product of the prior art does not necessarily or inherently possess characteristics or properties attributed to the claimed product. *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990); *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977).

Appellants do not dispute the Examiner’s finding that the materials forming the pouch, the method of making the pouch, and the materials found within the pouch are all substantially identical to the instant invention (*see generally* Br. and Reply Br.). Moreover, Appellants’ Specification states that “[t]he deformability of the unit dose form may be measured using an Instrom materials tester (or similar) according to [a particularly recited] procedure” (Spec. 3:24-32). Since the Appellants have chosen to define their invention by a property that must be determined experimentally, since the PTO does not have the means to conduct such experimental testing, and since the Examiner has provided sufficient and uncontested evidence that the invention appears otherwise substantially identical to the prior art, the burden has properly shifted to Appellants to prove that the prior art pouches do not have the degree of deformability recited in the claims. Appellants have submitted no such proof on this record.

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#### IV. CONCLUSION

On the record before us and for the reasons presented above, we sustain the rejections maintained by the Examiner.

#### V. DECISION

The decision of the Examiner is affirmed.

#### VI. TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

**AFFIRMED**

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